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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/444,261	11/22/1999	DANIEL JACOFF		8417
25889	7590	11/18/2003	EXAMINER	
WILLIAM COLLARD COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			VERBITSKY, GAIL KAPLAN	
		ART UNIT	PAPER NUMBER	2859

DATE MAILED: 11/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/444,261	JACOFF, DANIEL	
	Examiner	Art Unit	
	Gail Verbitsky	2859	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 24 September 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,8-11 and 13 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 1,8-11,20-25 and 43-45 is/are allowed.
- 6) Claim(s) 35-42 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 - a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ . |

Art Unit: 2859

DETAILED ACTION

Restriction/Election

1. Applicant's election with traverse of the invention of Group I, claims 1-25 and 35-45, is acknowledged. Accordingly, claims 26-34, drawn to non-elected invention, are withdrawn from further consideration.

Applicant states that the search for the vial would require to search for the mold and for the level. This argument is not persuasive because, although it is true for many vials, not all vials are necessarily made by making a mold, and used in levels, as well as some levels do not require vials. Furthermore, the methods of molding are known to be used for a vast variety of structures other than vials. Thus, the search for the vial would not require to search the level and mold areas. Therefore, the restriction requirement stated in Paper # 3 is hereby repeated and thus made

FINAL.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 35 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Wright in view of Ours.

Art Unit: 2859

Wright discloses in Fig. 1 a device in the field of applicant's endeavor, the device comprising an inner cavity having a curved surface of an inner wall 30, a straight cylindrical outer wall 16. Wright discloses an orienting means, keys, extending as an integral with the outer wall from an open end and extending in opposite direction to each other. The keys have an edge and a wall. The apex of the curved surface is formed closer to the outer wall than to the ends of the inner cavity. Planes tangents to opposed spaced sides E and F meet at 90 degrees at the apex. Planes H-I tangent to the sides of the cavity are parallel to each other and at 90 degree angles to the plane tangent to the apex. One end of the cavity is formed by terminating (closed end) 26. The open end of the device is closed with a cap. (The numerals E-I have been added by the Examiner, see attachment # 2 to the Office Action). The device is being formed by an injection molding.

Wright does not explicitly state that both, curved inner and straight cylindrical outer, surfaces/ walls are formed simultaneously, as stated in claim 35.

Ours teaches that by using an injection molding, all the surfaces of an article can be made simultaneously by injecting a material in a single step into a prepared mold.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of forming the device disclosed by Wright, so as to use a one step injection molding for simultaneously making an inner and an outer surfaces of the device, as taught by Ours, so as to minimize the time and costs of the manufacturing process.

Art Unit: 2859

The method steps will be met during the normal manufacturing process of the device stated above.

4. Claims 36-42 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Wright and Ours (U.S. 5595518), as applied to claim 35 above, and further in view of Johansson.

Wright and Ours disclose the device and the method as stated above in paragraph 3.

Wright does not teach that the inner cavity has a uniform cross section along the length, as stated in claims 36, 38, with the remaining limitations of claims 36-42.

Johansson discloses a device whose curved inner surface has a shape whose cross section is a uniform.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device disclosed by Wright and Ours, so as to have the inner cavity with a uniform cross section along the length, as taught by Johansson, because the courts have held that change in shape or configuration, without criticality, is within the level of skill in the art as the particular shape claimed by applicant is nothing more than one of the numerous shapes that a person having ordinary skill in the art will find obvious to provide. *In re Dailey*, 149 USPQ 47 (CCPA 1976).

With respect to claims 35-42: the method steps will be met during the normal manufacturing process of the device stated above.

Art Unit: 2859

Allowable Subject Matter

5. Claims 1, 8-11, 13, 20-25, 43-45 are allowed.

Response to Arguments

6. Applicant's arguments filed on September 24, 2003 have been fully considered but they are not persuasive.

Applicant states the inner cavity and outer wall are made simultaneously so as all vials to be identical.

This argument is not persuasive because the limitation upon which the applicant relies on (all vials are identical) is not stated in the claims. It is the claims that define the claimed invention. It is claims that are anticipated or unpatentable. Constant v. Advanced Micro-Devices, Inc., 7USPQ2d 1064.

Applicant states that Johansson and/ or Wright do not disclose a method of making a vial. This argument is not persuasive because, although Johansson and/ or Wright do not explicitly go over the method steps, it is inherent, that the vial of Johansson and/ or Wright must be manufactured before use.

Applicant states that Ours does not disclose a vial. Applicant states that the combination of Wright, Johansson and Ours does not disclose the invention claimed in claims 35-42 because Wright and Jonansson do not disclose a method of making. This argument is not persuasive because, Wright suggests to make the device by a method of an injection molding. Ours teaches

Art Unit: 2859

that by using an injection molding method, all the surfaces of an article can be made simultaneously by injecting a material in a single step into a prepared mold. Therefore, the combination of the three references teaches to manufacture a vial using an injection molding by simultaneously making all the surfaces.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication should be directed to the Examiner Verbitsky whose telephone number is (703) 306-5473.

Any inquiry of general nature should be directed to the Group receptionist whose telephone number is (703) 308-0956.

GKV

Application/Control Number: 09/444,261

Page 7

Art Unit: 2859

07 November 2003

Gail Verbitsky



Patent Examiner, TC 2800